

**REMARKS**

Claims 1-10, 73, and 74 remain pending in the application.

Rejection of Claims 1, 3, 4, 6, 7, and 8 under 35 U.S.C. §102(e)

Claims 1, 3, 4, 6, 7, and 8 have been rejected under 35 U.S.C. §102(e) as being anticipated by Wagner, et al., U.S. Patent No. 6,475,808 ("Wagner"). The Office Action asserts that Wagner teaches covalently immobilizing proteins to a solid support of an array.

At the outset, Applicants do not concede that Wagner is properly prior art to the claimed invention. Applicants reserve the right to establish an invention date for the claimed invention that is on or before the effective date of Wagner relied on by the Patent Office.

Applicants do not see where in Wagner is there a disclosure or a suggestion of a protein or protein fragment having a terminus forming a covalent bond with a linker molecule. According to the Office Action, Wagner teaches that a protein can be covalently immobilized to a solid support, for example, using maleimide or *N*-hydroxysuccinimide. However, nowhere does Wagner disclose or suggest that the terminus of a protein or protein fragment has been covalently bonded with a linker molecule. Wagner only discloses that proteins can be covalently immobilized to a substrate, and does not indicate that the terminus of the protein is involved with the covalent immobilization.

Accordingly, Wagner does not anticipate claim 1, and it is respectfully requested that the rejection of claim 1 be withdrawn. Claims 3, 4, 6, 7, and 8 depend, either directly or indirectly, from claim 1, and it is respectfully requested that the rejection of these claims also be withdrawn for at least the above-mentioned reasons.

Rejection of Claims 2 and 5 under 35 U.S.C. §103(a).

Claims 2 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wagner in view of Sakata, *et al.*, European Patent No. 0 140 489 ("Sakata") and Bagchi, *et al.*, U.S. Patent No. 4,855,219 ("Bagchi").

Claims 2 and 5 depend, either directly or indirectly, from Claim 1. According to the Office Action, the basis for the rejection is that Wagner teaches a system meeting all of the limitations of claim 1, except for the limitations added in claims 2 and 5. The Office Action

states that Sakata and Bagchi disclose such limitations, and that it would be obvious to combine Wagner with Sakata and Bagchi to add such additional features to the invention recited in claim 1.

For at least the reasons explained above with respect to the rejection under §102(e) in view of Wagner, the foundation for the rejection under §103(a) (i.e., that Wagner teaches all of the limitations of claim 1) is believed to have been overcome. Accordingly, the present rejection cannot stand. Moreover, Applicants do not concede that there would have been any motivation to combine Wagner with Sakata and Bagchi in the manner suggested in the Office Action, or that either Sakata or Bagchi discloses or suggests any of the additional limitations of the claims rejected on present basis. Thus, the rejection of claims 2 and 5 respectfully requested.

Rejection of Claims 9, 10, 73, and 74 under 35 U.S.C. §103(a)

Claims 9, 10, 73, and 74 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wagner in view of MacBeath et al., *J. Am. Chem. Soc.* 1999, 121: 7967-7968 ("MacBeath").

At the outset, Applicants note that MacBeath does not appear to have been publicly available more than one year prior to the earliest date to which the rejected claims may be entitled to the benefit of priority (i.e. August 3, 2000), and, therefore, do not concede that MacBeath is prior art to the claimed invention. Applicants reserve the right to establish an invention date for the claimed invention that is on or before the 1999 date when MacBeath became publicly available, which is the effective date of MacBeath relied on by the Patent Office.

Claims 9, 10, 73, and 74 depend, directly or indirectly, from claim 1. According to the Patent Office, the basis of the rejection is that Wagner teaches a system meeting all of the limitations of claim 1, except for the limitations added in claims 9, 10, 73, and 74. The Office Action states that MacBeath discloses such limitations, and that it would be obvious to combine Wagner with MacBeath to add such additional features to the invention.

For at least the reasons explained above, the foundation for rejection under §103(a) (i.e., that Wagner teaches all of the limitations of claim 1) is believed to have been overcome. Accordingly, while Applicants do not concede that there would have been any motivation to

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combine Wagner with MacBeath in the manner suggested in the Office Action, or that MacBeath discloses or suggests any of the additional limitations of the claims rejected on the present basis, the Applicants point out that present rejection cannot stand. Thus, withdrawal of this rejection or claims 9, 10, 73 and 74 is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representatives at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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